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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,823	02/17/2004	Wilbur Aaronson	16027-002001 / AAAARP01	3738
26161	7590	09/28/2007	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			WENDELL, MARK R	
		ART UNIT	PAPER NUMBER	
		3635		
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		09/28/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/780,823	AARONSON, WILBUR
	Examiner	Art Unit
	Mark R. Wendell	3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 September 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 9/13/07 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (5845441) in view of Lockwood (6854928). Swartz claims a pre-manufactured portable concrete structure comprising a floor, wall, and ceiling member detachable from one another (Swartz, Claims 1 and 11). It does not however disclose the use of a compliant, or protective, pad.

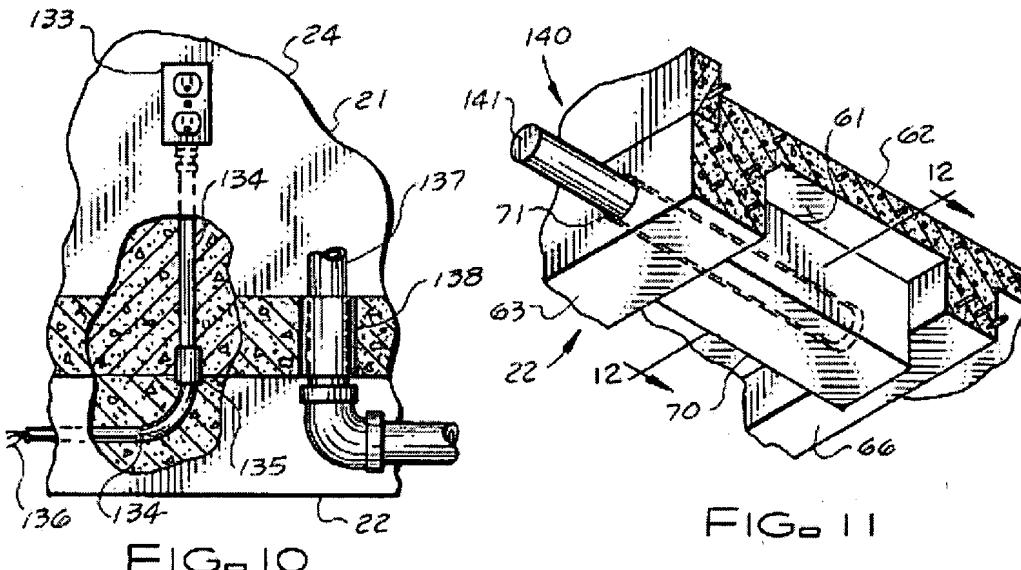
Lockwood discloses a rubber pad (44) between support structures (Column 2, line 41). It would be obvious to a person of ordinary skill in the art to have a protective (rubber) pad between adjacent concrete members, like that disclosed in Lockwood, to protect the members from damage during movement.

It is further noted, for Claim 2, that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (In re Leshin, 125 USPQ 416). It is well

known within the art that synthetic rubber significantly absorbs shock from movement and thus placing it between concrete members to prevent damage would be obvious.

In response to applicant's claim that the structure of Claim 1 can serve as a school classroom, an apartment unit, or an office space (Claims 11-13), a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The invention claimed in Swartz could be exercised for any of the intended uses claimed by the applicant in Claims 11-13.

Regarding claim 3, and the limitation of "a channeled layer attached to the floor and ceiling members," this same structure, defined as "interconnecting conduits," is disclosed in column 8, lines 19-24 of Swartz. Swartz also continues, Figures 10 and 11 (represented below) show "common means that typifies the inclusion of electrical, water, and sewage lines within and throughout the structure of the concrete house." The "common means" encompasses all conduits, openings, or channels for utilities to run through.



Regarding claim 4, the structure of Swartz combined with Lockwood as described above is considered a "composite system."

Regarding claim 5, the structure of Swartz combined with Lockwood as described above is considered "adapted to detachably engage" a second building module. It is well known in the art that one of ordinary skill could bolt two building modules to one another.

Regarding claim 9, the structure of Swartz combined with Lockwood as described above is considered "adapted for attachment to a preexisting structure." It is well known in the art that one of ordinary skill could bolt the building module to a preexisting structure.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (5845441) and Lockwood (6854928) in view of Fisher (4050213). It is well known in the art of building construction that removing a roof to add a second level is commonplace, thus it would be obvious to one of ordinary skill in the art to use the illustrations of Fisher (below) in conjunction with the disclosures of Swartz and Lockwood (described above) to arrive at the claimed material in claims 6 and 7.

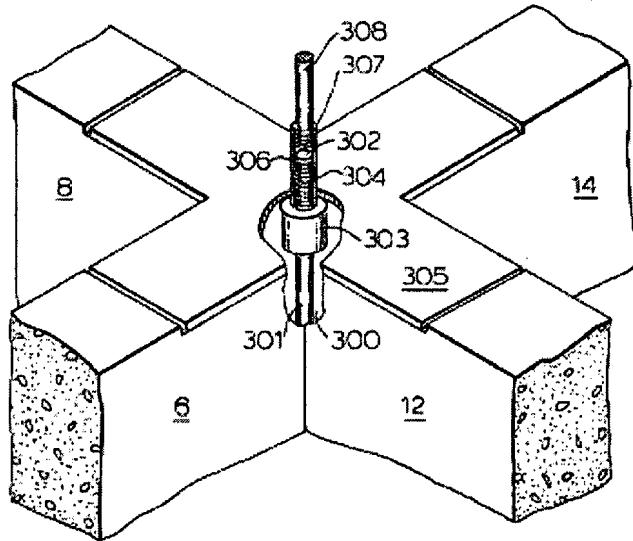


FIG. 5

Figure 5 of Fisher showing means for detachably engaging the structure to another.

(i.e. rod, screw, and nut)

FIG. 1

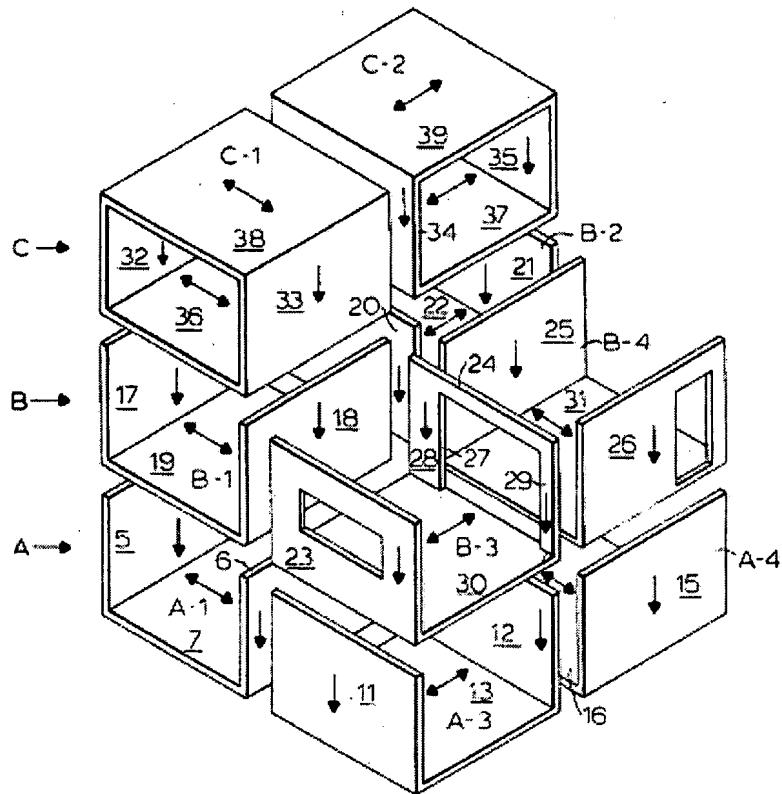
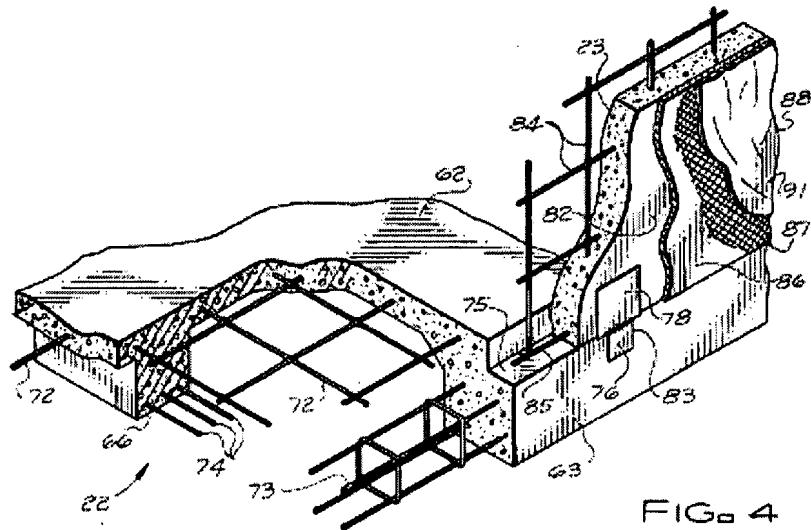


Figure 1 of Fisher showing structures connected horizontally and stacked vertically.

Regarding claim 8, Swartz discloses in column 8, lines 21-30, "...interconnecting conduits (134) join at connecting walls, floor/foundation (22) or ceiling roof sections..." This reads directly on a "conduit extending through the members" claimed in claim 8 of the application. The claimed "conduit" of claim 8 would also be considered obvious to one of ordinary skill in the art as stated in Swartz (column 8, lines 14-16), "common means that typifies the inclusion of electrical, water, and sewage lines within and throughout the structure of the concrete house."

Regarding claim 10, Swartz reveals in the drawings (91) and disclosure a "final paint coat system." This classifies, to a person of ordinary skill in the art, as an "exterior façade surface."



Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Menke (5265384) in view of Swartz (5845441) and Hoffman (6094873). Menke claims a "prefabricated living quarters structure to be received within an existing building." Menke, however, does not teach a pre-fabricated concrete structure.

Swartz claims a pre-manufactured portable concrete structure comprising a floor, wall, and ceiling member detachable from one another (Claims 1 and 11), reinforced with rebar (Figure 8, label 120), and a channeled layer or conduit. It would be obvious to one of ordinary skill in the art to combine pre-fabricated

living quarters of Menke with the portable concrete structure of Swartz because concrete structures are stronger and are produced in bulk more easily. Swartz does not teach a connecting layer composed of neoprene pads. It is, however, well known in the art to use neoprene pads to reduce damage from earthquakes or sudden movements (Hoffman, Claim 7). It would be obvious to one of ordinary skill in the art to use neoprene pads in the connecting layer if the connecting layer were to be used in conjunction with moving the structure.

It is further noted, for Claim 15, that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (In re Leshin, 125 USPQ 416). It is well known within the art that synthetic rubber significantly absorbs shock from movement and thus placing it between concrete members to prevent damage would be obvious.

Regarding claim 16, and the limitation of "a channeled layer attached to the floor and ceiling members," this same structure, defined as "interconnecting conduits," is disclosed in column 8, lines 19-24 of Swartz. Swartz also continues, Figures 10 and 11 (represented above) show "common means that typifies the inclusion of electrical, water, and sewage lines within and throughout the structure of the concrete house." The "common means" encompasses all conduits, openings, or channels for utilities to run through.

Regarding claim 17, the structure as described above is considered "adapted to detachably engage" a second building module. It is well known in the art that one of ordinary skill could bolt two building modules to one another.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menke (5265384) in view of Swartz (5845441) and Fisher (4050213). It is well known in the art of building construction that removing a roof to add a second level is commonplace, thus it would be obvious to one of ordinary skill in the art to use the illustrations of Fisher (above) in conjunction with the disclosures of Menke and Swartz (described above) to arrive at the claimed material in claims 18 and 19.

Regarding claim 20, Swartz discloses in column 8, lines 21-30, "...interconnecting conduits (134) join at connecting walls, floor/foundation (22) or ceiling roof sections..." This reads directly on a "conduit extending through the members" claimed in claim 20 of the application. The claimed "conduit" of claim 20 would also be considered obvious to one of ordinary skill in the art as stated in Swartz (column 8, lines 14-16), "common means that typifies the inclusion of electrical, water, and sewage lines within and throughout the structure of the concrete house."

Response to Arguments

Applicant's arguments filed 9/13/2007 have been fully considered but they are not persuasive. In response to applicant's argument that the examiner's conclusion of

obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The examiner notes, with regard to applicants destroying the function argument, a tight coupling would still exist if a rubber protective pad were inserted prior to coupling the adjacent panels. The connection would act much like a rubber washer in that the connection would be enhanced and virtually airtight, in addition to acting as a protective entity during movement.

In regards to the applicants argument:

"With regard to the contention regarding a matter of obvious design choice, that is a conclusion, not a reason in support of rejection. In In re Garrett, 33 PTCJ 43 (BPA&I, September 30, 1986) the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" as a conclusion, not a reason, in reversing the section 103 rejection."

The examiner notes that Lockwood does in fact recite in Column 2, lines 9-10 the protective pad being made from a rubber. Synthetic rubber, as claimed by the

applicant, falls under the umbrella of the limitation "rubber" disclosed within Lockwood. Furthermore, the rejection based on design choice is not intended by the examiner to be a conclusion, rather a rejection which is clearly stated in the statement, "it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice."

In regards to the applicants argument:

"Like the secondary reference, the primary reference also discloses adjacent panels tightly interconnected. Thus, combining the references as proposed by the Examiner would destroy the functions of the primary and secondary references in having the adjacent panels tightly interconnected."

The examiner notes that the references would not in fact be destroyed. The intended purpose of Menke's pre-fabricated living quarters, as disclosed within the title and throughout the specification, is to be attached within an existing building (Swartz). Menke's invention would be constructed within, or added onto, the building of Swartz and there would be no destruction of either reference.

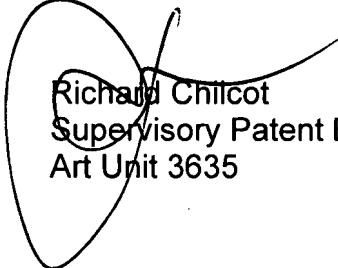
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Wendell whose telephone number is (571) 270-

3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Chilcot
Supervisory Patent Examiner
Art Unit 3635

MRW
September 21, 2007